

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Applicant: Stephen J. Brown

Application No.: 09/237,194

Examiner: Morgan, R.

Filed: January 26, 1999

Art Group: 3626

For: REMOTE HEALTH-MONITORING SYSTEM WITH NETWORKED
SERVER AND HEALTH CARE PROFESSIONAL

REPLY BRIEF

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P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits the following Reply Brief pursuant to 37 C.F.R. §41.37 for consideration
by the Board of Patent Appeals and Interferences.

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I. STATUS OF CLAIMS

Claims 1-33 have been cancelled. Claims 34-138 are pending and remain rejected.

The Appellant hereby appeals the rejection of claims 34-138.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The first ground of rejection to be reviewed is whether claims 34-41, 45-50, 52, 54-59, 61-63, 66, 69-75, 77-84, 88-93, 95, 97-102, 104-106, 108, 109 and 112-118 are patentable under 35 U.S.C. §103 over Fu et al.¹ and Lee² in view of Kirk et al.³

The second ground of rejection to be reviewed is whether claims 42, 44, 85 and 87 are patentable under 35 U.S.C. §103 over Fu, Lee and Kirk and further in view of Beckers.⁴

The third ground of rejection is whether claims 51, 53, 60, 64, 67, 68, 94,96, 103, 107, 110 and 111 are patentable under 35 U.S.C. §103 over Fu, Lee and Kirk and further in view of Fujimoto.⁵

The fourth ground of rejection to be reviewed is whether claims 43 and 86 are patentable under 35 U.S.C. §103 over Fu, Lee and Kirk, and further in view of the Examiner's use of Official Notice.

The fifth ground of rejection to be reviewed is whether claims 76 and 119-138 are patentable under 35 U.S.C. §103 over Fu, Lee and Kirk, and further in view of Examiner's use of Official Notice.

¹ U.S. Patent No. 4,803,625; hereinafter Fu.

² U.S. Patent No. 4,838,275.

³ U.S. Patent No. 5,390,238; hereinafter Kirk.

⁴ U.S. Patent No. 5,019,974.

⁵ U.S. Patent No. 5,339,821.

III. ARGUMENTS IN RESPONSE TO EXAMINER'S ANSWER

- A. Combination of Kirk with other references is not proper where Appellant has established conception of the invention occurred prior to the effective filing date of Kirk and Appellant has presented evidence on the record, in the form of a Declaration under 37 CFR 1.131 and 28 exhibits, showing reasonable diligence coupling the conception to a constructive reduction to practice through the filing of the patent application to which the instant application claims priority.

An Applicant may overcome a 35 U.S.C. §103 rejection based on a combination of references by showing completion of the invention by the Applicant prior to the effective date of any of the references.⁶ The Applicant need not antedate the reference with the earliest filing date.⁷ The Applicant may antedate, and thus remove, a reference as prior art by providing evidence of prior conception of the invention coupled with reasonable diligence beginning prior to the effective reference date until either an actual reduction to practice of the invention or the filing of the patent application.⁸ Appellant has presented evidence of prior conception and reasonable diligence by filing the Declaration of Stephen J. Brown under 37 CFR § 1.131 (Rule 131) accompanied by 28 exhibits.⁹ In pertinent part, Rule 131 reads:

Sec. 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim *** may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The

⁶ Manual of Patent Examining Procedure (MPEP), Eighth Edition, Rev. 7, July 2008, §715.02(I).

⁷ *Id.*

⁸ 37 CFR §1.131.

⁹ Filed September 19, 2006.

effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). ***.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

The first question presented by Rule 131 is whether Appellant has established invention of the subject matter of the rejected claims prior to the effective date of the reference or activity on which the rejection is based. The Examiner has “respectfully submitted that the documents submitted by the [Appellant] indicate that conception of the invention took place prior to June 15, 1992.”¹⁰ Thus, Appellant has met the first prong of Rule 131.

The remaining question under Rule 131 is whether the Appellant, by presenting the Declaration of Stephen J. Brown under 37 CFR 1.131 and 28 exhibits, has established that the prior conception was coupled with due diligence from prior to June 15, 1992 to November 17, 1992, the effective filing date of the application. The Examiner has cited MPEP §2138.06 as stating (emphasis by Examiner):

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently

¹⁰ See page 15, lines 17-18 of the Examiner’s Answer, dated July 7, 2008.

reduced to practice” is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

However, MPEP §2138.06 also indicates that proof of reasonable diligence does not require the inventor to work constantly on the invention or to drop all other work.¹¹ In particular, MPEP §2138.06 states:

The diligence of 35 U.S.C. 102(g) relates to **reasonable** “attorney-diligence” and “engineering-diligence” **which does not require that “an inventor or his attorney drop all other work and concentrate on the particular invention involved”**.¹²

The fact that the Appellant need not drop everything and work only on the invention is further evidenced by the Federal Circuit’s decision in *Monsanto Co. v. Mycogen Plant Science, Inc.*¹³ In *Monsanto*, the Court stated:

The law regarding diligence is settled.

¹¹ *Mycogen Plant Science, Inc., v. Monsanto Co.*, 252 F.3d 1306, 1316, 58 USPQ2d 1891, 1899 (Fed. Cir. 2001), reh’g denied, 261 F.3d 1345, 59 USPQ2d 1852 (Fed. Cir. 2001); see *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986).

¹² MPEP §2138.06, citing *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959) and *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974) (emphasis by Appellant’s representative).

¹³ 261 F.3d 1356, 59 USPQ2d 1930 (Fed. Cir. 2001); hereinafter *Monsanto*.

However, **there need not necessarily be evidence of activity on every single day if a satisfactory explanation is evidenced.** Proof of reasonable diligence, however, does not require a party to work constantly on the invention or to drop all other work [citing *Mycogen Plant Science, Inc. v. Monsanto Co.*, 252 F.3d 1306, 1316, 58 USPQ2d 1891, 1899 (Fed. Cir. 2001)].¹⁴

The Declaration of Stephen J. Brown¹⁵ clearly is specific as to dates and facts and provides satisfactory explanations to excuse a requirement for evidence of activity on every single day. Specifically, paragraph 10 of the Declaration of Stephen J. Brown¹⁶ states:

During the period from March 2, 1992 to November 17, 1992, I was either diligently working on the present invention, or performing my other duties as CEO of the company. The time line has been detailed with various documents attached as Exhibits C to AB, which are described below.

Paragraph 11 of the Declaration of Stephen J. Brown¹⁷ states:

My duties as CEO included preparing applications for grants, which directly contributed to financing needed to develop and produce products related to the present invention, traveling, attending conferences, as well as other items related to the day to day running of the company. As is common for most CEOs, I worked hours far in excess of the normal 40 hour week.

¹⁴ *Id.* (emphasis by Appellant's representative).

¹⁵ Filed September 19, 2006.

¹⁶ Filed September 19, 2006.

¹⁷ Filed September 19, 2006.

Paragraphs 11-32 and 35-46 of the Declaration of Stephen J. Brown¹⁸ and the referenced exhibits account for affirmative acts either taken in furtherance of the present invention or related to Appellant's duties as CEO. Paragraphs 33 and 34 of the Declaration of Stephen J. Brown¹⁹ account for time when Appellant was with his family. Paragraph 29 of the Declaration of Stephen J. Brown²⁰ and Exhibit Q provide evidence of the employment of an individual during the period from June 1992 to December 1992 whose work included development of the present invention. Thus, Appellant has submitted evidence showing that work toward reducing the invention to practice was ongoing and providing satisfactory explanations (e.g., the extensive demands on Appellant as CEO of a start-up company) to excuse a requirement for proof that activity took place on every single day.

Furthermore, in *Monsanto* the Court cited *Jones v. Evans*²¹ as finding diligence despite a possible interval from April 16 to early in July in which it did not affirmatively appear that any steps were being taken, but during which some activity was ongoing. The Declaration of Stephen J. Brown²² and associated exhibits clearly evidence that activity on the present invention was ongoing during the period from prior to the filing date of *Kirk* (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992).

¹⁸ Filed September 19, 2006.

¹⁹ Filed September 19, 2006.

²⁰ Filed September 19, 2006.

²¹ 46 F.2d 197, 202, 8 USPQ 240, 245 (1931).

²² Filed September 19, 2006.

Furthermore, the full time employment of Jack Thornton as Director of Product Development during the period from June 1992 through December 1992 and the fact that his job included working on the specifications for the present invention²³ provide evidence that activity on the present invention was ongoing during the period from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). In particular, the Circuit Court for Patent Appeals has stated:

Although the law is well settled that a completed invention requires both conception and reduction to practice, there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf.²⁴

Therefore, here, as in *Jones v. Evans*, the Declaration of Stephen J. Brown²⁵ and associated exhibits factually support that Appellant was reasonably diligent from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992).

Furthermore, the Examiner's statement that the exhibits describe only a patient interface system but have no integration of the overall system including a physician interface until Exhibit T dated August 13, 1992,²⁶ does not appear to recognize that the efforts taken by the

²³ See paragraph 20 of the Declaration of Stephen J. Brown and Exhibit Q, filed September 19, 2006.

²⁴ *In re Braun*, 687 F.2d 459, 214 USPQ 933, 936 (C.C.P.A. 1982) (citing *Litchfield v. Eigen*, 535 F.2d 72, 76, 190 USPQ 113, 116 (C.C.P.A. 1976)).

²⁵ Filed September 19, 2006.

²⁶ See page 16, starting six lines from the bottom, of the Examiner's Answer, dated July 7, 2008.

Appellant need not be the most expeditious, but rather it is enough that the efforts taken lead to a reduction to practice.²⁷ Specifically, MPEP §2138.06 states:

Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. “[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....”²⁸

In the case of the present invention as in the case of *Justus*, it is immaterial to the question of reasonable diligence whether the exhibits have no integration of the overall system including a physician interface until Exhibit T dated August 13, 1992. The Examiner has acknowledged that the integration of the overall system is in fact evidenced by the Declaration of Stephen J. Brown and the 28 associated exhibits.

Furthermore, the Declaration of Stephen J. Brown²⁹ sets forth facts to support that the efforts made were part of an overall scheme of inventive activity directed toward reducing the invention to practice. In *In re Jolley*,³⁰ the Federal Circuit found that the PTO Board did not err in determining that it was reasonable for a party to test a simpler composition (e.g., X and Z) as a step toward reducing a more complex composition (e.g., X+Y+Z) to practice. Here as in *Jolley*, the Appellant’s efforts on individual parts of the claimed invention prior to the integration of the

²⁷ See MPEP §2138.06, citing *Justus v. Appenzeller*.

²⁸ MPEP §2138.06, citing *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971).

²⁹ Filed September 19, 2006.

³⁰ 308 F.3d 1317, 64 USPQ2d 1901 (Fed. Cir. 2002).

individual parts is reasonable and therefore supports that Appellant was reasonably diligent from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992).

Furthermore, the Examiner's statement that "the Exhibits have at least 2 days of inactivity and the Applicant has not providing [sic] an acceptable excuse in order to account for time lapse between these lapses" appears to be an indirect reference to *In re Mulder*,³¹ cited in M.P.E.P. §2138.06 as a case where "a 2-day period lacking activity has been held to be fatal."³² However, *Mulder* is not dispositive to the present case. Specifically, in *Mulder*, the Court stated:

A liberal construction of [Rule 131], which is clearly intended to benefit applicants, will permit applicants to show diligence from just prior to the date of the reference to their convention filing date, rather than all the way from their proven conception date, but liberality cannot be extended to the point of eliminating all proof of diligence, no matter how short the period to be covered. **Appellants' difficulty, as they have had to admit, is that there is no evidence whatever of record showing diligence, and therefore they cannot comply with the rule. Focusing on the shortness of the gap is misleading.** During the period between the time the draft application was received in this country and the time the application was filed in the U.S. PTO, the record shows no activity of any kind in this country. . . . Under the circumstances, the PTO's refusal to accept the declarations as meeting the requirements of Rule 131 must be affirmed **because of the total lack of evidence** of diligence to couple conception to the filing date--leaving a hiatus--and Rodgers must be treated as prior art.³³

³¹ 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983).

³² See MPEP §2138.06, citing *In re Mulder*.

³³ 716 F.2d at 1545, 219 USPQ at 193 (emphasis added by Appellant's representative).

The record in the present case, unlike in Mulder, clearly contains extensive evidence showing activity occurring from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). Thus, unlike in Mulder, the present record does not suffer from a total lack of evidence of diligence to couple the prior conception of the present invention from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992).. Thus, in contrast to Mulder, the Declaration of Stephen J. Brown³⁴ and the associated exhibits factually support that Appellant was reasonably diligent from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). Therefore, Kirk is not available as prior art against the claims.

For the reasons presented above, the Examiner's conclusion "As such, it is submitted that the Applicant has failed to provide evidence with respect to works directly related to the reduction to practice of the invention and providing an acceptable excuse for the time lapse between months showing reasonable due diligence"³⁵ is not supported by the record. As such, the combination of Kirk with other references as a basis for the rejections of the present claims is not proper and the rejections should be reversed.

³⁴ Filed September 19, 2006.

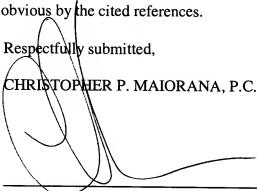
³⁵ See page 17, lines 1-4 of the Examiner's Answer, dated July 7, 2008.

B. CONCLUSION

Appellant has provided specific evidence of prior conception coupled with reasonable diligence from prior to June 15, 1992, the effective filing date of Kirk, until November 17, 1992, the effective filing date of the present application. In particular, the Declaration of Stephen J. Brown and the associated Exhibits A-AB, which were filed on September 19, 2006, provide specific evidence of reasonable diligence from just prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). The presently claimed invention was conceived prior to the effective date of Kirk and diligently reduced to practice through the filing of the patent application to which the present application claims priority. Hence, the Examiner has clearly erred with respect to the patentability of the claimed invention. It is respectfully requested that the Board overturn the Examiner's rejections of all pending claims, and hold that the claims are not rendered obvious by the cited references.

Respectfully submitted,

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Dated: September 4, 2008

c/o Sandeep Jaggi
Health Hero Network

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